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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,261	02/03/2000	Nicholas J. Mankovich	US000036	8558

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
ABDI, KAMBIZ	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/498,261	MANKOVICH ET AL.	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-10,15 and 17-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-10,15 and 17-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The prior office actions dated;

05/06/2002
11/15/2002
02/24/2003
08/25/2003
12/29/2003
07/20/2004
01/26/2005

2. is incorporated herein by reference in addition to any intermediary communications. In particular, the observations with respect to claim language, responses to any previously presented arguments, and specific rejection reasoning.

- Claims 1, 7, 15, 22, 24, and 26 have been amended.
- No new claims have been added.
- Claims 1-5, 7-10, 15, and 17-26 are pending.

3. Rejection of claims 1-5, 7-10, and 15-26 under 35 U.S.C. § 112 have been withdrawn based on response and explanations made by the applicant.

Response to Arguments

4. Applicant's arguments filed 2 may 2005 have been fully considered but they are not persuasive in addition to that the arguments are moot in view of new grounds of rejections based on the amendments made by the applicants to the independent claims.

5. However, the examiner would like to clarify and expand on the comments and arguments that have been made by the applicant in regards to independent claim 1.

6. As for the applicant's assertion of failure of providing of *prima facie* case is in err. Examiner would like to point to the office action, which clearly provides the motivation for enhancing the control over the content as it is distributed (in order to make it more controllable from the point of view of the content owner and from the revenue point of view). In addition, there is no indication of storing or retaining of such content within the rendering device of the claim. One can look at the claim and consider the rendering

once as it is broadcasted and subsequent to obtaining authorization (i.e. purchasing a CD) for additional rendering of content. It is clearly stated in the Anderson reference of such rendering device (See Anderson column 8, line 62- column 9, line 7).

7. In regards to the phrase "capable of..." it should be clear that the phrase renders the step that is proceeded by the phrase "capable of..." does not necessarily dictate that the step is performed. It only states that the system is "capable" and there is a possibility of such step occurring and it is not positively reciting such a step taking place. For example the rendering of such content in a broadcasting media such as radio would be playing of the broadcast song over the air for at least once during the broadcast, and further playback would be of purchased CD of such song by the rendering device.

8. As for the arguments put forward by the applicant in regards to the separation of different parts of the system, it is clearly stated by the Chen reference that components can be combines into an integrated unit as it would be an obvious modification to a person skilled in the art would modify the components for the purposes of compactness and integrality of the system.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-2, 4-5, 7-9, 15, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent No. 5,892,900 to Karl L. Ginter further in view of U.S. Patent No. 5,991,601 to John R. Anderson.

11. As per claims 1, 7, 15, 21, 23, and 25 Chen discloses a receiving device, system, and method comprising:

- a content access device that is configured to receive content material and an identifier associated with the content material from a provider (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14);
- a purchase request processor is configured to receive a purchase request for the content material from an input device and produces therefrom a processed purchase request; and (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14)
- a rendering device configured to render the content material to a user; (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14)
- wherein the content access device is further configured to communicate the processed purchase request; and (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14)

What is not clearly defined by the Chen reference is the rendering device is capable of rendering the content material a limited number of times prior to the purchase request and subsequently rendering the content material additional times after an authorization is received in response to the purchase request. It should be understood that Chen reference is capable of rendering the content at least once. However, Ginter clearly teaches that content can be rendered before the purchase has occurred and once a purchase has transacted number of times a rendering can occur is limited to a certain number of times as well as duration of time or date limitations (See Ginter column 52, line 21-column 59, line 61, column 137, line 51-column 138, line 63, column 140, lines 25-38, column 153, lines 29-58, column 263, lines 54-61, and column 317, lines 43-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate a method of pre-

purchase rendering and limited number of time rendering to Chen system in order to make it more controllable from the point of view of the content owner and from the revenue point of view.

Further, Anderson clearly teaches that the content material is rendered to a user in addition to Chen references teaching that as well by the way of the receiver being the rendering device of content in conjunction with processing station (See Anderson column 8, line 62- column 9, line 7).It would have been obvious to one having ordinary skill in the art at the time the current invention was made to include the convenience of ready availability of content to be rendered as sampling item or as the actual content to be purchased rather to wait for the CD to be shipped or any other method that does not have the immediacy of delivery to the user.

12. As per claims 2, 4-5, 8, 9, and 16, Chen and Ginter clearly disclose all the limitations of claims 1, 7, and 15, further;

Chen discloses,

- wherein the content access device is further configured to associate the purchase request and the identifier based on a coincidence of a time of receipt of the purchase request and a time interval associated with the rendering of the content material (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).
- the purchase request processor is further configured to receive a transferred purchase request and a transferred identifier, and to produce there from the processed purchase request.
- the purchase request processor is further configured to receive certification information associated with the purchase request (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- wherein the processed purchase request includes the certification information (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

- a "buy" switch (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- wherein the purchase request from the input device is produced in response to an activation of the "buy" switch (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

13. As per claims 3 and 10, Chen and Ginter disclose all the limitations of claims 1 and 7as discussed above. What Chen does not explicitly teach is the system to store content within a memory before access rights have been granted. However, Anderson clearly teaches a system and method for identification of a digital content based on a broadcast. Anderson teaches how to access a system to obtain such a digital item before usage right has been granted and store this digital content in a local memory (See Anderson column 8, lines 43-68 and column 9, lines 1-10 and 25-36).

14. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to simply provide content to the users within the local memory before the usage rights or authorization has been granted. One good example of this kind digital content would be the software items. Traditionally software is delivered through a medium such as floppy disks, CD-ROMs, Magnetic Tapes, or via the Internet. There are many software vendors that include the entire application or the game or any other content within the first delivery of content but limit the usage to either a limited time period or just a limited version of the application. Once the purchase process has been completed and an authorization has been received the entire digital content becomes available to the consumer.

15. As per claim 19, Chen and Ginter clearly disclose all the limitations of claim 15, further; Chen discloses,

- transferring the purchase request to one or more intermediary devices (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and

- wherein communicating the purchase request to the provider is via the one or more intermediary devices (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

16. As per claim 20, Chen and Ginter clearly disclose all the limitations of claim 15, further; Chen discloses,

- further including attaching certification information to the purchase request that is communicated to the provider (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

17. Claims 22, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent No. 5,892,900 to Karl L. Ginter as applied to claims 1, and 7 above, and further in view of Patent No. 6,708,157 to Mark J. Stefik.

18. As for claims 22 and 24, Chen and Ginter disclose all the limitations of claims 21and 23, further; Stefik discloses, the rendering device is capable of using a first ticket to render the content material once; and the rendering device is capable of using a second ticket to render the content material additional times (See Stefik abstract, column 3, line58-column 4, line 32, column 22, lines 14-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Stefik with that of teachings of Chen and Ginter for further securing the usage and control over distribution of the content material.

19. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent No. 5,892,900 to Karl L. Ginter as applied to

claim 15 above, and further in view of John R. Anderson, Patent No. 5,991,601 and Roy J. Mankovitz, Patent No. 5,949,492.

20. As for claims 17 and 18 Chen and Ginter disclose all the limitations of claim 15 as discussed above. What Chen does not explicitly teach is the system to store content within a memory before access rights have been granted. Additionally, Chen does not explicitly teach the relationship between content identification and the time interval in conjunction with the rendering of the material. However, Anderson clearly teaches a system and method for identification of a digital content based on a broadcast. Anderson teaches how to access a system to obtain such a digital item before usage right has been granted and store this digital content in a local memory (See Anderson column 8, lines 43-68 and column 9, lines 1-10 and 25-36). The same argument of motivation can be stated as it has been discussed in the above claim.

21. In addition Mankovitz explicitly teaches a system for identification of the rendered material based on function of time in relation to the station that broadcasts the material (See Mankovitz column 2, lines 60-68 and column 3, lines 1-58). Identification of rendered material through a simultaneous broadcast of item identification along with the rendered material or usage of time, date, station call name combination or any combination thereof is a well known in the art and all aspects of these methods have been discussed in the above mentioned patents. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate a method of identifying a broadcast material based on relative information such as time, date, station call id in conjunction with other identifiable information from the broadcasting program.

22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response,

to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

25. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://portal.uspto.gov/external/portal/pair.**

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

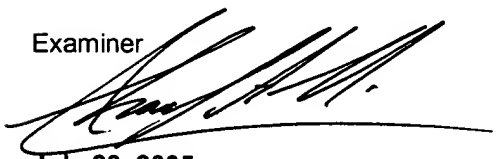
(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi

Examiner



July 20, 2005